

REMARKS

Claims 14-20 have been amended to correct an inadvertent error, since the claim upon which they directly or indirectly depend (i.e., claim 9) is a method claim, not a composition claim.

Entry of the above amendment is respectfully requested.

Information Disclosure Statement

Applicants note that attached to the Office Action, the Examiner has lined out the citation for EP 0 308 135 on the PTO/SB/08 form filed February 7, 2006, because a copy of the reference was not provided. In this regard, Applicants note that this reference was supposed to be provided to the PTO by the International Bureau, but apparently it was not provided. Accordingly, Applicants submit herewith an Information Disclosure Statement including a copy of this reference. Applicants respectfully request that the Examiner consider the disclosed information and return an initialed PTO/SB/08 form with the next communication from the PTO.

Provisional Obviousness-Type Double Patenting Rejection

On page 3 of the Office Action, in paragraph 2, claims 9 and 14-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 3, 6, 12 and 14 of copending Application No. 11/794,120 in view of Johnstone (US 6,262,105 B1).

In response, Applicants submit that copending Application No. 11/794,120 has been abandoned, so the rejection is moot.

Applicants note that copending Application No. 12/534,775 is a continuation of Application No. 11/794,120, but Applicants defer acting with respect to the '775 application, since no rejection has been made yet with respect to that application.

Obviousness Rejection

On page 5 of the Office Action, in paragraph 1, claims 9 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnstone (US 6,262,105 B1) in view of Skuballa et al. (US 4,088,775).

In response, Applicants note initially that Skuballa describes in the Abstract that compounds including 13,14-dihydro-15,15-ethylenedioxy-20-ethyl PGF₂α have an activity spectrum similar to but stronger and longer lasting than natural PGF₂α, and in the specification, Skuballa indicates that some PGF₂α derivatives having an ethylenedioxy group on the C-15 atom exert stronger abortive activity than natural PGF₂α (see column 10, line 61 to column 11, line 46). However, in the specification, Skuballa also describes “The effective agents of this invention pertaining to the F series have a lesser bronchoconstrictive effect than natural prostaglandin F₂α, which is of the great advantage for their therapeutic use” (see column 12, lines 6-9). Thus, from not only the Abstract but also from the entire specification of Skuballa, one skilled in the art can understand that enhancement of the activity which is achieved by substitution of a hydroxy group with an ethylenedioxy group on the C-15 atom depends on what the activity is. In other words, from Skuballa, it can be understood that the introduction of an ethylenedioxy group on the C-15 atom enhances some activities possessed by PGF₂α, but decreases other activities possessed by PGF₂α.

Therefore, Applicants submit that contrary to the Examiner's indication that one skilled in the art would expect 13,14-dihydro-15,15-ethylenedioxy-20-ethyl PGF2 α isopropyl ester to have similar activities as taught in Johnstone (i.e., hair growth promoting activity) because it is a PGF2 α derivative, which should have better activity than other PGF2 α derivatives because of the teachings of Skuballa, one skilled in the art would not have expected 13,14-dihydro-15,15-ethylenedioxy-20-ethyl PGF2 α isopropyl ester to have similar activities as taught in Johnstone taking the entire disclosure of Skuballa into consideration. In this regard, Applicants submit that it would not have been obvious to combine the teachings of Johnstone and 13,14-dihydro-15,15-ethylenedioxy-20-ethyl PGF2 α isopropyl ester taught by Skuballa.

Further, Applicants could submit herewith a Rule 132 Declaration with the experimental data (an executed version of the Declaration will be submitted promptly after it is received by the undersigned). In particular, the data show that hair growth promoting effect exerted by PGF2 α does not correlate to the IOP effect which latanoprost exerts as disclosed by Johnstone. In this regard, Applicants submit that Rescula[®] (the comparative embodiment, which is 13,14-dihydro-15-keto-20-ethyl PGF2 α isopropyl ester) is closer to the elected species than latanoprost, since Rescula[®] includes 20-ethyl while latanoprost does not, and thus Rescula[®] is an appropriate comparative embodiment.

In the light of the foregoing, Applicants submit that one skilled in the art would not have been motivated to combine the teaching of Johnstone and 13,14-dihydro-15,15-ethylenedioxy-20-ethyl PGF2 α isopropyl ester taught by Skuballa.

Accordingly, Applicants submit that the present invention is not obvious over the cited art, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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